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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,671	12/20/2005	Anders Vikso Nielsen	10473.204-US	3643
25908 7590 11/15/2010 NOVOZYMES NORTH AMERICA, INC. 500 FIFTH AVENUE SUITE 1600 NEW YORK, NY 10110				
EXAMINER MACAULEY, SHERIDAN R				
ART UNIT 1651		PAPER NUMBER		
NOTIFICATION DATE 11/15/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-NY@novozymes.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/561,671

Applicant(s)

NIELSEN ET AL.

Examiner

SHERIDAN R. MACAULEY

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 13 October 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 47-59.

Claim(s) withdrawn from consideration: 61-65.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☒ Other: See Continuation Sheet.

/Ruth A. Davis/
Primary Examiner, Art Unit 1651

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments have been considered but they have not been found to be persuasive. Applicant argues that the references cited in the Office action mailed on 14 April 2010 do not render the claimed invention obvious because the prior art does not teach an enzyme comprising an amino acid sequence having 90% homology to the amino acid sequence of SEQ ID NO:2. However, the alignment is cited only to provide evidence of inherent characteristics of prior art Bacillus enzymes, and need not itself be a prior art reference. The alignment provides evidence that enzymes containing the characteristics recited in the claims, specifically the recited homology to SEQ ID NO:2, existed in the art at the time of the invention in alpha-amylases of Bacillus spp. At the time of the invention, the use of such enzymes in processes such as those recited in the claims was known in the art. Since the art suggests that a variety of Bacillus enzymes are suitable for use in these methods, one of ordinary skill in the art would have recognized that a suitable enzyme could have been selected from a number of enzymes, and thus a Bacillus enzyme possessing the claimed characteristics could have been chosen from a finite number of predictable solutions, as discussed in the above rejections. Applicant is reminded that discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new; thus the claiming of a new use, functions or unknown property that is inherently present in the prior art does not necessarily make the claim patentable (see MPEP 2112). Since enzymes possessing the claimed characteristics were known at the time of the art, as were processes of using similar enzymes in prior art processes, the discovery of a new property (i.e., the sequence the enzyme), does not render the prior art enzyme patentable. Although applicant further argues that Alignment 1 (which can be found as Result 1 under the Alignments section in the search results filed on August 6, 2009 and again on January 28, 2010) discloses only a carbohydrate binding module (CBM) and not an alpha-amylase, it is noted that the alignment not only discloses that the sequence is a CBM and that alpha-amylases may possess this CBM (see, for instance, the description of claim 2 is the supporting information included with Alignment 1). Therefore, the alignment does provide evidence that prior art alpha-amylases could have been selected that possessed the characteristics recited in the claims and applicant's arguments have not been found to be persuasive.

Continuation of 13. Other: It is noted that the claims filed in applicant's response received on 13 October 2010 are not amended relative to the claims under examination in the Office action mailed on 14 April 2010. Therefore, the claims filed on 13 October 2010 do not raise any issues requiring further search and/or consideration and have been entered.